

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

APPLICANT : HUBERT BARTH, ET AL. EXAMINER : Not Assigned Yet
SERIAL NO : 09/869,871 ART UNIT : Not Assigned Yet
FILED : JULY 6, 2001 PAPER NO :
FOR : METHOD FOR PRODUCING SYMMETRICAL AND ASYMMETRICAL
CARBONATES

**PETITION UNDER 37 CFR 1.181 TO WITHDRAW
HOLDING OF ABANDONMENT**

July 22, 2002

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

Applicants recently became aware that the above-captioned application has been placed in the abandoned files for allegedly failure to respond to a Notice of Missing Requirements. Applicants in fact responded to the Notice of Missing Requirements in a timely fashion. Accordingly, the application was marked abandoned by error by the U.S. Patent and Trademark Office, and withdraw of the holding of abandonment is therefore requested.

A Notice of Missing Requirements for the captioned application was mailed on August 22, 2001. A copy of the Notice is enclosed herewith. The Notice indicated that a reply was due by within two months. Applicants' attorney response to the Notice of Missing Requirements was mailed on October 23, 2001 and was accompanied by a request for a one month extension under 37 CFR 1.136(a) and the required fee. Applicants' response was mailed to the USPTO with Certificate of Mailing dated October 23, 2001. A copy of the signed and dated Response to Notice of Missing Requirements and the papers accompanying the response is enclosed. Applicants enclosed a self-addressed stamped receipt postcard with the Response

USSN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US

to Notice of Missing Requirements, and said postcard was stamped by the USPTO on February 19, 2001. A copy of the stamped postcard is enclosed.

Applicants' made a timely reply to the Notice of Missing Requirements in the captioned application, and receipt was acknowledged by the USPTO. Accordingly, the holding of abandonment of the application for failure to reply to the Notice of Missing Requirements was in error. Therefore, applicants request withdraw of the holding of Abandonment and passage of the case to issue.

Because this error was made in the Patent and Trademark Office, no fee is believed to be required. However, authorization is hereby given to charge any fee deemed to be required to Deposit Account No. 23-0455, and the Commissioner is hereby authorized to charge any greater amount as may be required or credit any overpayment to Deposit Account No. 23-0455.

Respectfully submitted,



Cynthia M. Bott
Registration No. 46,568
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105
Tel. (734) 622-4476
Fax (734) 622-1553

Attachments - Transmittal Form

Return copy of Notice of Abandonment under 37 CFR 1.53(f) or (g)
Associate Power of Attorney
Copy of Notice of Missing Requirements
Copy of the signed and dated Response to Notice of Missing Requirements and
Attachment
Copy of the stamped receipt postcard
Certificate of Mailing By "Express Mail" (37 CFR 1.10)

THE UNITED STATES PATENT AND TRADEMARK OFFICE IS IN RECEIPT OF A RESPONSE TO THE NOTICE OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 FOR INVENTORS HUBERT BARTH, ET AL. FOR INVENTION ENTITLED "METHOD FOR PRODUCING SYMMETRICAL AND ASYMMETRICAL CARBONATES", USSN 09/869,871 FILED JULY 6, 2001. AUTHORIZATION IS GIVEN TO CHARGE THE PROCESSING FEE AND THE ONE-MONTH EXTENSION TO DEPOSIT ACCOUNT 23-0455, AND ANY ADDITIONAL FEES OR CREDIT ANY OVERPAYMENT TO SAME ACCOUNT.

CERTIFICATE OF MAILING (37 CFR 1.8)

RECEIVED

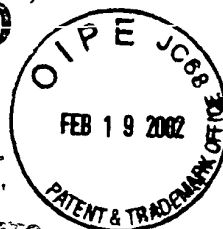
MAR 08 2002

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OCTOBER 23, 2001

PD-6381-08-CA

USA PATENT DEPT.



IC10 REG PCT/PTO 19 FEB 2002

ant
3/15/02

USSN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US

**Response To Notice To File Missing Parts Of Application
Filing Date Granted (PTO-1533)(Large Entity)**

Docket No.
6381-08-CA

In Re Application Of: **Hubert Barth, et al.**

Serial No.
09/869,871

Filing Date
7/6/01

Examiner

Group Art Unit

Invention: **METHOD FOR PRODUCING SYMMETRICAL AND ASYMMETRICAL CARBONATES**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

This is a response to the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533) mailed on
8/22/01
Date

Enclosed herewith for filing are the following:

- ☒ A copy of the Notice to File Missing Parts of Application - Filing Date Granted (PTO-1533). **(REQUIRED)**
- ☐ An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date.
- ☐ A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date.
- ☐ An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date.
- ☒ A verified English translation of the non-English language application papers as originally filed. It is requested that this translation be used as the copy for examination purposes in the United States Patent and Trademark Office.
- ☐ Other (list):

USN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US

**Response To Notice To File Missing Parts Of Application
Filing Date Granted (PTO-1533)(Large Entity)**

Docket No. **#**
6381-08-CA

In Re Application Of: **Hubert Barth, et al.**

Serial No.
09/869,871

Filing Date
7/6/01

Examiner

Group Art Unit

Invention: **METHOD FOR PRODUCING SYMMETRICAL AND ASYMMETRICAL CARBONATES**

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

☒ Completion of application fees as calculated below:

☐ Utility application filing fee

☐ Design application filing fee

☐ Total number of independent claims =

☐ Total number of claims =

☐ Multiple dependent claims

☐ Surcharge for late payment of filing fee and/or late filing of original declaration or oath

☐ Petition and fee for filing by other than all the inventors or a person not the inventor

☒ Fee for processing an application filed with a non-English language specification **\$130.00**

☐ Fee for processing and retention of application

Total completion of application fees **\$130.00**

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a response to the above-identified Notice to File Missing Parts of Application. The requested extension is as follows (check time period desired). If an additional time extension is required, please consider this a petition therefor.

☒ One month ☐ Two months ☐ Three months ☐ Four months ☐ Five months

from: **October 22, 2001** until: **November 22, 2001**
Date Date

Total time extension fees **\$110.00**

Total fees due **\$240.00**

Response To Notice To File Missing Parts Of Application
Filing Date Granted (PTO-1533) (Large Entity)

PCT/PTO

Docket No.
22 JUL 2001
6381-00 CA

In Re Application Of: Hubert Barth, et al.

Serial No.
09/869,871

Filing Date
7/6/01

Examiner

Group Art Unit

Invention: METHOD FOR PRODUCING SYMMETRICAL AND ASYMMETRICAL CARBONATES

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Box Missing Parts

The fee of \$240.00 is to be paid as follows:

- ☐ A check in the amount of the fee is enclosed.
- ☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 23-0455.
A duplicate copy of this sheet is enclosed.
- ☒ If an additional extension of time is required, please consider this a petition therefor and charge any additional fees which may be required to Deposit Account No. 23-0455.
A duplicate copy of this sheet is enclosed.



Signature

Dated: October 23, 2001

Charles W. Ashbrook
Registration No. 27,610

Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, MI 48105
Phone: (734) 622-5215
Fax: (734) 622-1553

I certify that this document and fee is being deposited on October 23, 2001 with the U.S. Postal Service as first class mail under 37 C.F.R. 1.8 and is addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.



Signature of Person Mailing Correspondence

Cindy Malocha

Typed or Printed Name of Person Mailing Correspondence

CC:



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents, Box PCT
United States Patent and Trademark Office
Washington, D.C. 20231
www.uspto.gov

U.S. APPLICATION NO.	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
09/869871	BARTH H	6381-08-IM
INTERNATIONAL APPLICATION NO.		
PCT/EP00/00340		
I.A. FILING DATE	PRIORITY DATE	
18 JAN 00	09 FEB 99	

CHARLES W ASHBROOK
WARNER LAMBERT
2800 PLYMOUTH ROAD
ANN ARBOR, MI 48105

DATE MAILED: 22 AUG 2001

AUG 30 2001

RECEIVED

NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)

1. The following items have been submitted by the applicant or the IB to the United States Patent and Trademark Office as ☐ a Designated Office (37 CFR 1.494) ☒ an Elected Office (37 CFR 1.495):

- ☒ U.S. Basic National Fee. ☐ Indication of Small Entity Status.
☒ Copy of the international application. ☐ Translation of the international application into English.
☐ Oath or Declaration of inventors(s). ☐ Translation of Article 19 amendments into English.
☐ Copy of Article 19 amendments. ☐ Other:
☐ Priority Document.
☐ The International Preliminary Examination Report in English and its Annexes, if any.
☐ Translation of Annexes to the International Preliminary Examination Report into English.

2. ☐ Applicant has requested early processing under 35 U.S.C. 371(f) but has not filed the following indicated items and/or the indicated items in paragraph 3 below. The Basic National Fee and the copy of the international application must be filed prior to 20 or 30 months from the priority date to avoid abandonment.

- ☐ U.S. Basic National Fee. ☐ Copy of the international application.

3. The following items **MUST** be furnished within the period set forth below in order to complete the requirements for acceptance under 35 U.S.C. 371:

- ☒ a. Translation of the application into English. A processing fee will be required if submitted later than the appropriate 20 or 30 months from the priority date.
☐ The current translation is defective for the reasons indicated on the attached Notice of Defective Translation.
☒ b. Processing fee for providing the translation of the application and/or the Annexes later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(f)).
☐ c. Oath or declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), properly identifying the application (preferably by the International application number and international filing date). A surcharge will be required if submitted later than the appropriate 20 or 30 months from the priority date.
☐ The current oath or declaration does not comply with 37 CFR 1.497(a) and (b) for the reasons indicated on the attached PCT/DO/EO/917.
☐ d. Surcharge for providing the oath or declaration later than the appropriate 20 or 30 months from the priority date (37 CFR 1.492(e)).

4. Additional claim fees of \$_____ as a ☐ large entity ☐ small entity, including any required multiple dependent claim fee, are required. Applicant must submit the additional claim fees or cancel the additional claims for which fees are due (37 CFR 1.492(g)). See attached PTO-875.5. ☐ Applicant has not submitted the required sequence listing pursuant to 37 CFR 1.821-1.825. See attached PCT/DO/EO/920.**ALL OF THE ITEMS SET FORTH IN 3(a)-(d), 4 AND 5 ABOVE MUST BE SUBMITTED WITHIN TWO (2) MONTHS FROM THE DATE OF THIS NOTICE OR BY 22 OR 32 MONTHS (where 37 CFR 1.495 applies) FROM THE PRIORITY DATE FOR THE APPLICATION, WHICHEVER IS LATER. FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT.**

The time period set above may be extended by filing a petition and fee for extension of time under the provisions of 37 CFR 1.136(a).

6. If box 3a or 3c is checked, a translation of the Annexes **MUST** be submitted no later than the time period set above or the Annexes will be cancelled. A processing fee will be required if submitted later than 20 or 30 months from the priority date.
 7. ☐ The Article 19 amendments are cancelled since a translation was not provided by the appropriate 20 (37 CFR 1.494(d)) or 30 (37 CFR 1.495(d)) months from the priority date.

Applicant is reminded that any communication to the United States Patent and Trademark Office must be mailed to the address given in the heading and include the U.S. application no. shown above. (37 CFR 1.5)

A copy of this notice MUST be returned with this response.

- Enclosed: ☐ PCT/DO/EO/917 ☐ Notice of Defective Translation
☐ PTO-875 ☐ PCT/DO/EO/920

Paulette Kidwell, Paralegal

FORM PCT/DO/EO/905 (March 2001)

Telephone: 703-305-3656

USPN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US

017645

DOCKETED
Date 10/22/2001
For Missing Parts - CA

7/26/01

DT06 Rec'd PCT/PTO 22 JUL 2002

Please type a plus sign (+) inside this box → ☐PTO/SB/21 (6-98)
Approved for use through 09/30/2000. OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>	Application Number	09/869,871	
	Filing Date	July 6, 2001	
	First Named Inventor	Hubert Barth, et al.	
	Group Art Unit	Not Yet Assigned	
	Examiner Name	Not Yet Assigned	
Total Number of Pages in This Submission		Attorney Docket Number	6381-08-CA

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition Routing Slip (PTO/SB/69) and Accompanying Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Small Entity Statement <input type="checkbox"/> Request for Refund	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Additional Enclosure(s) (please identify below): Petition Under 37 CFR 1.181 Associate Power of Attorney Certificate of Express Mail Copies of Response to Notice of Missing Requirements and papers accompanying the response Return Postcard
<input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s)		
<input type="checkbox"/> Extension of Time Request		
<input type="checkbox"/> Express Abandonment Request		
<input type="checkbox"/> Information Disclosure Statement		
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Cynthia M. Bott
Signature	<i>Cynthia M Bott</i>
Date	7-22-02

CERTIFICATE OF MAILING		
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: <input type="text"/>		
Typed or printed name		
Signature		Date

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

USSN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US

**Associate Power of Attorney Or Agent (37 CFR 1.34)
(For Representation Related To A Patent Application)**

Docket No.
6386-01-CA

In Re Application Of: Hubert Barth, et al.

Serial No.
09/889,341

Filing Date
July 16, 2001

Examiner
Not Assigned Yet

Group Art
Not Assigned Yet

Invention: METHOD FOR ARYLATING AZA-HETERO-CYCLES WITH ACTIVATED AROMATIC COMPOUNDS IN THE PRESENCE OF CESIUM CARBONATE

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Please recognize the following as ☒ Associate Attorney ☐ Associate Agent in this application.

Name: Cynthia M. Bott

Reg. No.: 46,568

Address: Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, Michigan 48105

Tel. No. (734) 622-4476


Signature of Principal Attorney or Agent of Record

Francis J. Tinney
Registration No. 33,069
Warner-Lambert Company
2800 Plymouth Road
Ann Arbor, Michigan 48105
Telephone: (734) 622-7295
Facsimile: (734) 622-1553

Registration Number & Address of Principal Attorney or Agent of Record

Dated: July 22, 2002

I certify that this document is being deposited on _____
with the U.S. Postal Service as first
class mail under 37 C.F.R. 1.8 and is addressed to the
Assistant Commissioner for Patents, Washington, D.C.
20231.

Signature of Person Mailing Correspondence

Typed or Printed Name of Person Mailing Correspondence

USSN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US

REC'D PCT/PTC

22

JUL-2002

CERTIFICATE OF MAILING BY "EXPRESS MAIL" (37 CFR 1.10)

Applicant(s): Hubert Barth, et al.

Docket No.

6381-08-CA

Serial No.

09/869,871

Filing Date

6-Jul-2001

Examiner

Group Art

Invention:

METHOD FOR PRODUCING SYMMETRICAL AND ASYMMETRICAL CARBONATES

I hereby certify that this Petition Under 37 CFR 1.181 To Withdraw Holding of Abandonment

(Identify type of correspondence)

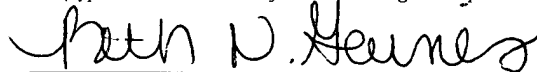
Is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under
37 CFR 1.10 in an envelope addressed to: The Assistant Commissioner for Patents, Washington, D.C. 20231

on July 22, 2002

(Date)

Beth N. Gaines

(Typed or Printed Name of Person Mailing Correspondence)



(Signature of Person Mailing Correspondence)

EF220788287US

("Express Mail" Mailing Label Number)

Note: Each paper must have its own certificate of mailing

USSN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO./TITLE
09/869,871		Hubert Barth	6381-08-IM

CONFIRMATION NO. 1246

Charles W Ashbrook
Warner Lambert
2800 Plymouth Road
Ann Arbor, MI 48105

**ABANDONMENT/TERMINATION
LETTER**



OC000000008219597

Date Mailed: 06/03/2002

NOTICE OF ABANDONMENT UNDER 37 CFR 1.53 (f) OR (g)

The above-identified application is abandoned for failure to timely or properly reply to the Notice to File Missing Parts (Notice) mailed on 08/22/2001.

- No reply was received.

A petition to the Commissioner under 37 CFR 1.137 may be filed requesting that the application be revived.

Under 37 CFR 1.137(a), a petition requesting the application be revived on the grounds of **UNAVOIDABLE DELAY** must be filed promptly after the applicant becomes aware of the abandonment and such petition must be accompanied by: (1) an adequate showing of the cause of unavoidable delay; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(l); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Under 37 CFR 1.137(b), a petition requesting the application be revived on the grounds of **UNINTENTIONAL DELAY** must be filed promptly after applicant becomes aware of the abandonment and such petition must be accompanied by: (1) a statement that the entire delay was unintentional; (2) the required reply to the above-identified Notice; (3) the petition fee set forth in 37 CFR 1.17(m); and (4) a terminal disclaimer if required by 37 CFR 1.137(d).

Any questions concerning petitions to revive should be directed to "Office of Petitions" at (703) 305-9282.

*A copy of this notice **MUST** be returned with the reply.*

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

USSN: 09/869,871 Filed on: July 6, 2001
Express Mail: EF220788287US